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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/470,580 | 12/22/1999 | STEVEN B. SOLOMON | 067251.0104 | 6336 |

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,580

Applicant(s)

SOLOMON ET AL.

Examiner

James W Myhre

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-11,13,14,16-31 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-11,13,14,16-31 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 12, 2004 has been entered.

Response to Amendment

2. The amendment filed on December 8, 2003 under 37 CFR 1.116 has been considered but is ineffective to overcome the Small (5,791,991) and Walker et al (6,330,544) references. The amendment canceled Claims 2, 5, 12, 15, and 32. Therefore, the currently pending claims which have considered below are Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38.

Claim Rejections - 35 USC § 101

3. The amendment filed on December 8, 2003 has overcome the rejection of Claims 1-20 and 31-38 under 35 U.S.C. 101 in paragraph 3 of paper number 16. Therefore, the Examiner hereby withdraws that rejection.

Double Patenting

4. Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 of this application conflict with claims 1-32 of Application No. 09/470, 588. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Both applications pertain to processing a rebate either as a cash rebate or as a credit voucher rebate. Both applications contain claims which are directed to processing the credit voucher during a subsequent purchase by the consumer using the same steps. Although the two applications contain slightly different terminology and/or semantics, the steps involved in each application to process the claimed rebates are the same. For example, Claim 31 of Application 09/470,588 is a method which includes the steps of Claims 1, 5, 6, and 31: (a) identifying a product bearing a rebate based on input received from a user; (b) receiving consumer information from the user, the consumer information identifying a purchase of a product; (c) communicating the consumer information to a remote rebate processing center using a communications network; (d) receiving rebate information from the remote rebate processing center using the communications network, the rebate information comprising a transaction identifier identifying the rebate for the product and the purchase of the product; (e) receiving at least two disbursement options for the user to receive the rebate; (f) receiving a

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selected one of the disbursement options from the user, wherein the disbursement options comprise a cash rebate or a credit voucher valid for purchases at a limited scope of retail sites, wherein a cash value of the credit voucher is greater than the cash rebate; and (g) outputting a rebate request form comprising the transaction identifier, the transaction identifier for physical delivery to the remote rebate processing center.

Claim 31 of the present application is also a method which includes the steps of (a) receiving purchase information identifying a product bearing a rebate; (b) communicating the purchase information to a remote rebate processing center; (c) receiving rebate information describing the rebate from the remote rebate processing center, the rebate information comprising at least two disbursement option, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and (d) displaying the rebate information.

When examining the correspondence of the features in the two claims one finds that steps (a) and (b) of the '588 application equate to step (a) of the current application; step (c) of the '588 application corresponds to step (b) of the current application; steps (d)-(f) of the '588 application correspond to step (c) of the current application; and step (g) of the '588 application corresponds to step (d) of the current application.

Many of the other dependent claims in the current application have corresponding claims which include the exact same wording in the other application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (5,791,991) in view of Walker et al (6,330,544), and Finsterwald (6,039,244).

Claims 1, 11, 21, 25, and 31: Small discloses a method and apparatus for processing rebates, comprising:

- a. Displaying a plurality of product identifiers associated with products bearing a rebate (col 7, lines 52-54);
 - b. Receiving purchase information from a user indicating purchase of one of the identified products (col 8, lines 20-24);
 - c. Receiving a rebate request along with a transaction identifier (col 8, lines 18-24);
 - d. Retrieving and displaying status information pertaining to the rebate request;
 - e. Receiving authorization of the rebate request;
 - f. Displaying rebate information retrieved from a remote processing center including at least two disbursement options of different cash values (col 7, lines 36-43);
- and

g. Receiving a selection of the disbursement option (col 7, lines 36-43).

While Small explicitly discloses that the cash value of the two options may differ, (col 8, lines 51-54), Official Notice is also taken that it is old and well known within the retail arts to offer incentives whose value varies in accordance with predetermined criteria. examples of these types of incentive offers are: quantity discounts where the greater number of like items bought, the greater the percentage of discount received; total purchase discounts where the higher the total purchase price, the higher the discount received; and a variety of rebate offers. In further support of this Official Notice, the examiner has previously provided an article by Guglielmo from *MacWeek*, October 24, 1989, which shows that customers who buy a Mac computer had two options: a rebate of \$150 - \$300 on other products offered by Apple Computers, or an option to return the hardware (for cash). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to give the consumer in Small options of various values. One would have been motivated to have the credit voucher larger than a cash rebate in order to entice the customer to select that offer, hence spending the rebate value back in the store.

While Small does not explicitly disclose that the rebate processing center will authorize the rebate by comparing the information received with the rebate requirements, Walker discloses a similar rebate processing method in which the rebate processing center verifies the authenticity and validity of the information and then transmits a rebate authorization (col 9, lines 20-60 and col 18, lines 11-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to authenticate the rebate request in Small and to communicate the authorization. One would have been motivated to verify the information in order to prevent awarding fraudulent rebates.

While Small does not disclose retrieving and display status information for the rebate request, Walker discloses maintaining a "status" field in the database to indicate the status of a rebate, e.g. issued, redeemed, etc. Finsterwald discloses another similar rebate processing system in which that status of the rebate request is displayed to the user (col 10, lines 21-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to notify the customer in Small of the current status of the rebate request, such as approved, denied, processing, etc. One would have been motivated to notify the customer of the status of the rebate in order to provide better customer service and to enable the customer to provide additional information if needed.

Claims 3 and 13: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1 and 11 above, and Small further discloses searching for the requested product (col 7, lines 52-54). It also would have been obvious to allow a user to enter search criteria when trying to locate a specific product out of the large number of products usually carried by any one merchant. One would have been motivated to utilize a search engine of some sort in this manner in order to preclude the user having to manually read through possibly thousands of items in order to identify the desired product.

Claims 4, 14, and 24: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, and 21 above. While Small also discloses that the consumer may receive a credit voucher, it is not explicitly disclosed that the consumer uses the credit voucher to purchase one or more subsequent products. However, Walker discloses using the credit voucher to offset the cost in a subsequent purchase (col 9, line 20-40 and col 18, lines 11-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the credit voucher issued by Small during a subsequent purchase transaction by the consumer. One would have been motivated to use the credit voucher during a subsequent transaction in order to allow the consumer to actually receive the "value" of the rebate while decreasing the store's outgoing cash flow. The Examiner notes that this is the inherent use of credit vouchers within society.

Claims 6, 16, 26, 33, and 34: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above, and Small further discloses that displaying a list of products to whose purchase the rebate may be applied is old and well known and uses the example from the 1950's and 1960's of consumers selecting products out of catalogs when redeeming trade stamp books. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display a list of products as Small's "prize redemption alternatives". One would have been motivated to display a list of products from which the consumer can select when redeeming the rebate and to also display the total price

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of the selected products in order to allow the consumer to ascertain whether rebate funds were available to cover an additional products.

Claims 7, 17, 27, and 35: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 6, 16, 26, and 34 above. Walker further discloses using other forms of payment, such as cash or credit cards, when the credit voucher does not cover the complete cost of the subsequent purchase transaction (col 9, lines 20-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a credit card in Small to cover any part of the subsequent transaction not covered by the credit voucher. One would have been motivated to use another payment method, such as a credit card, in order to allow the consumer to purchase larger (more expensive) or more numerous items during the subsequent transaction.

Claims 8, 18, 28, and 36: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above. Walker further discloses using a browser to link to a site for making a subsequent purchase (Figure 12, item 1212 and col 20, lines 2-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to direct the consumer in Small to a site where the credit voucher could be used. One would have been motivated to direct the consumer thereto in order to provide the consumer an easy and quick way to redeem the credit voucher, while at the same time providing the merchant with another sale.

Claims 9, 19, 29, and 37: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above, and Small further discloses the consumer having the options of receiving a cash rebate or a credit voucher (col 7, lines 36-43).

Claims 10, 20, 30, and 38: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above, and Small further discloses that the credit voucher comprises one of a retailer gift certificate, manufacturer credit voucher, or a credit valid for an Internet purchase (col 7, lines 36-43).

Claim 22: Small, Walker, and Finsterwald discloses an apparatus for processing rebates as in Claim 21 above, and Small further discloses matching the rebate request with the promotion (col 7, lines 56-63 and col 8, lines 20-24).

Response to Arguments

7. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Freeman et al (6,450,407) discloses a method and apparatus for

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processing rebates which includes displaying products for purchase to the consumer. receiving product selections and rebate request from the consumer, and processing the rebate over the Internet.

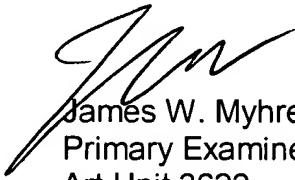
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM

February 10, 2004


James W. Myhre
Primary Examiner
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